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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/840,475 | 04/23/2001 | Michael J. Sullivan | P-4628-D1-1-C1-1 | 5756 |

24492 7590 07/26/2004

THE TOP-FLITE GOLF COMPANY, A WHOLLY OWNED
SUBSIDIARY OF CALLAWAY GOLF COMPANY
P.O. BOX 901
425 MEADOW STREET
CHICOPEE, MA 01021-0901

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| EXAMINER |
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BUTTNER, DAVID J

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| ART UNIT | PAPER NUMBER |
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1712

DATE MAILED: 07/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|-------------------------------|---------------------------------|--|
| Office Action Summary | Application No. 09/840,475 | Applicant(s) SULLIVAN ET AL. | |
| | Examiner David Buttner | Art Unit 1712 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/6/04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-14,17 and 19-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-14,17 and 19-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Parent application 9-562773 lacks metal fillers and the specific gravity and therefore does not provide basis for any current claim.

Parent application 8-870585 (boded on review of US 6210293) lacks thermoplastic centers and therefore does not provide basis for any current claim.

The effective filing data for the current claims is 4/23/01.

Claims 1,2, 5-14, 17, 19-23, 25, 26 and 28 are rejected under 35 U.S.C. 102(b and e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the Melvin '562 Patent.

Melvin discloses golf balls having a center core, outer core and at least two cover layers (col. 5 line 1-4). The core layers can be thermoplastic (col. 5 line 29). The center should have a high specific gravity (col 7 line 58). This can be achieved by adding fillers (col. 7 line 62). The filler can be tungsten (col. 7 line 55). The outer cover can be a urethane (col. 18 line 49-53). The outer cover is softer than the inner cover (col. 14 line 57). If the multitude of choices is not considered anticipated, the reference at least renders obvious the claim as every limitation is suggested.

Claims 1,2, 5-14, 17 and 19-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Melvin '562 Patent in view of Sullivan '119.

Melvin does not suggest titanium filler or reaction injection molding the urethane cover. Sullivan lists titanium and tungsten as alternative metal fillers for golf balls (col. 29).

It would have been obvious to substitute Melvin's tungsten with titanium to adjust the density to any desired level.

Sullivan also teaches reaction injection molding is one method of placing urethane cover on golf balls (col. 19, line 61).

It would have been obvious to use any known techniques to mold Melvin's urethane cover (including RIM).

Applicant's arguments filed 5/6/04 have been fully considered but they are not persuasive.

Applicant argues Melvin does not teach each element of applicant's invention and therefore cannot be anticipatory.

Applicant fails to point out which limitation Melvin is unable to meet. Therefore, the anticipatory rejection remains.

Applicant argues Melvin qualifies as prior art under 102(e) when used in the obviousness rejections. Applicant contends the common ownership precludes the use of Melvin in any obviousness rejection.

This is not convincing. Melvin was published 7/14/98. This is more than two years prior to applicant's effective filing date of 4/23/01. Melvin qualifies as prior art under 102 (b) and 102 (e). The commonly owned Melvin reference is not disqualified from use in obviousness rejections (see MPEP 706.02 (1) (3)).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Buttner whose telephone number is (571) 272-1084. The examiner can normally be reached on Weekdays from 10:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DAVID J. BUTTNER
PRIMARY EXAMINER

D. Buttner/af
July 15, 2004

